

REMARKS

At the time of this response, claims 1-20 are pending. No claims have been amended, so claims 1-20 appear as originally or previously presented. The Applicant respectfully traverses the 35 USC § 103 rejections in the OA, and requests their withdrawal for the reasons below.

I. The OA fails to comply with the MPEP because it does not address nine of Applicant's prior arguments.

Examiners must consider any obviousness rejection "in view of the entire record" and review each rejection "to confirm their continued viability." MPEP § 2141. The OA, however, contains only one response to Applicant's previously-submitted arguments: that the "Applicant's arguments ... are moot in view of new ground(s) of rejection." (OA, page 10, lines 10-11). Applicant respectfully disagrees with this analysis, since only arguments affected by the new grounds would be moot in light of these new grounds. Thus, the following nine arguments in Applicant's October 9, 2008 Amendment have not been responded to:

- 1) III(A)(2) ("Toda teaches away from the other references and the present invention");
- 2) III(A)(3) and III(B)(4) ("The OA fails to consider the claimed invention as a whole");
- 3) III(A)(4) ("Bayles, Vaidyanathan and Toda are Non-Analogous Art"), III(A)(5);
- 4) III(B)(6) ("The prior art references are combined using impermissible hindsight");
- 5) III(B)(1) ("Bayles, Wilson and Vaidyanathan do not show the claimed limitations");
- 6) III(A)(2) ("'Administration web site' has a different meaning to one skilled in the art");
- 7) III(A)(3) ("Wilson teaches away from the other references and the present invention.");
- 8) III(A)(5) ("Bayles, Wilson and Vaidyanathan are Non-Analogous Art"); and
- 9) IV ("Response to Arguments").

Applicant respectfully requests consideration of—and response to—all such argument (made in view of the entire record) as directed by MPEP § 2141.

II. Claim Rejections – 35 USC § 103

The OA rejected claims 1-5 and 11-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,039,697 to Bayles (Bayles) in view of U.S. Patent Application Publication No. 2002/0138291 to Vaidyanathan et al. (Vaidyanathan) further in view of U.S. Patent Application Publication No. 2002/0138291 to Toda et al. (Toda), further in view of U.S. Patent Application Publication No. 2002/0061021 to Douglas M. Dillon (Dillon). The OA also rejected claims 6-10 and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over Bayles in view of U.S. Patent No. 7,007,080 to Wilson (Wilson) in further view of Vaidyanathan.

Applicant respectfully traverses these rejections because the OA does not establish prima facie obviousness. Prima facie obviousness requires that the claimed limitations be taught or suggested by the cited prior art. MPEP § 2143.03. The arguments below show that the claimed limitations are not taught or suggested by the cited prior art.

A. Independent claims 1 and 11 (and their dependent claims) should be allowed because the cited art does not teach a domain name reseller guiding customers to a domain name registrar's website.

Independent claims 1 and 11 both contain the limitation of “at least one of the plurality of Customers” being “guided to the registrar web site from actions by one of the plurality of Resellers” Dillon, however, fails to teach this limitation. The cited portion of Dillon (paragraph [101]) teaches only a web crawler that “gathers URL data items for a channel and places them into packages.” But it does not teach or suggest a registrar web site that registered a domain name. In fact, the word “registrar” does not appear anywhere in the Dillon reference.

Nor does Dillon show that a customer was guided. The customer in Dillon is not guided at all because they select and subscribe to (rather than being guided to) desired web site content, which is then received on the customer's hard disk. (See Dillon, paragraphs [0049] and [0052]).

Applicant therefore respectfully requests allowance of independent claims 1 and 11 and their respective dependent claims (2-5 and 12-15).

- B. Independent claims 6 and 16 (and their dependent claims) should be allowed because the cited art does not teach an administration web site for allowing resellers to enter the reseller program and customize the registrar web site for their customers.**

Independent claims 6 and 16 both contain the limitation of “an administration web site for allowing Resellers to enter the reseller program and allowing each Reseller to customize the registrar web site for their Customers.” The cited portion of Wilson teaches “an administration website that displays who is connected to the network, who is registered, time and date of registration, etc.” (See Wilson, column 5, lines 7-8). But it does not teach an administration web site which allows resellers to customize the registrar web site for their customers. The cited portion of Wilson is the only place where the words “administration” and “web site” appear near each other in the entire reference.

Applicant therefore respectfully requests allowance of claims 6 and 16 and their respective dependent claims (7-10 and 17-20).

- 1. The OA’s interpretation of the term: “administration web site” differs from the meaning this term would have to one of one skilled in the art.**

During examination, claim terms must be interpreted according to “a hypothetical ‘person having ordinary skill in the art’ who must “have the capability of understanding the scientific and engineering principles applicable to the pertinent art.” MPEP § 2141.03.

As evidenced by the claim’s explicit language, one of ordinary skill would understand that one purpose of the “administration web site” of claims 6 and 16 is “to customize the registrar web site.” By contrast, the cited portion of Wilson (Wilson, column 5, lines 7-8) teaches “an administration website that displays who is connected to the network, who is registered, time and date of registration, etc.” Wilson’s definition of “Administration” means administration of network access resources in “multiple unit buildings such as hotels.” (Wilson, Abstract). It does not teach the claimed “administration web site . . . to customize the registrar web site,” as the term is explicitly claimed and would therefore be understood in the art.

Applicant therefore respectfully requests allowance of claims 6 and 16 and their respective dependent claims (7-10 and 17-20).

C. Claims 1-20 should be allowed because the OA improperly combines multiple references to meet the claimed limitations.

1. The prior art teaches away from the present invention.

“A prima facie case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.” MPEP § 2144.05. Claims 1 and 11 include a customer being guided to a web site that registered a domain name. Dillon teaches multicasting “selected web site content (called ‘channels’) onto a receiving computer’s hard disk, making that content available at ‘hard disk’ speed.” (Dillon [0023], emphasis added). Instead of a customer being guided to the website content, Dillon teaches the content from the website is being brought to and cached on the customer’s hard disk. Dillon teaches information flowing in the opposite direction from the claimed invention, thereby teaching away from the claimed invention.

Dillon also teaches away from the claimed invention because, instead of being guided, the customer in Dillon “subscribes to channels of interest and only subscribed channels are received and stored on the user’s receiving terminal.” (Dillon [0049] and [0052]). This means the customer is choosing rather than being guided to the desired website content.

Wilson likewise teaches away from the claimed invention. Claims 6 and 16 include an administration web site for allowing resellers to enter the reseller program and allowing each reseller to customize the registrar web site for their customers. Wilson discloses a system that “is a server-only solution and ... is designed to operate without modifications.” (Wilson, column 5, lines 11-19) These limitations taught by Wilson teach away from the claimed administration web site whose very purpose is to modify and customize the registrar web site for their customers.

Because the cited prior art teaches away from the claimed invention, Applicant respectfully requests allowance of claims 1-20.

2. The OA fails to consider the claimed invention as a whole.

“In determining the differences between the prior art and the claims, the question under § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” Likewise, “Distilling an invention down to the

‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter ‘as a whole.’” MPEP § 2141.02.

The OA does not establish prima facie obviousness because it does not consider the claimed invention as a whole. One of the core novelties in claims 1 and 11 of the claimed invention is a customer being guided to a web site that registered a domain name. The OA does not show this limitation with prior art citations or a showing of obviousness. When the claimed invention, including a customer being guided to a web site that registered a domain name is considered as a whole it becomes clear that it is not obvious over the prior art. Applicant therefore respectfully requests the allowance of claims 1-5 and 11-15.

Another core novelty in claims 6 and 16 of the claimed invention is an administration web site for allowing resellers to customize the registrar web site for their customers. When the claimed invention, including an administration web site for allowing resellers to customize the registrar web site for their customers is considered as a whole it becomes clear that it is not obvious over the prior art. Applicant therefore respectfully requests the allowance of claims 6-10 and 16-20.

3. The prior art references are non-analogous art.

To show that references are analogous “the similarities and differences in structure and function of the inventions” must be analyzed. Analogous prior art must either be in the same field of endeavor or pertinent to the problem to be solved. MPEP § 2141.01(a).

None of the references used to reject claims 1-5 and 11-15 are pertinent to the problem the others are trying to solve. For example, Bayles’ computer node naming resolution process is irrelevant to the problems solved by Vaidyanathan’s digital file marketplace. Likewise, Vaidyanathan’s digital file marketplace is not pertinent to problems solved by Toda’s site monitoring method, and Dillon’s multicasting multimedia content is not pertinent to solving any of these problems.

Likewise, in the rejection of claims 6-10 and 16-20, Bayles’ computer node naming resolution process is irrelevant to the problems solved by Wilson’s system for reconfiguring and registering a new IP address for a computer to access a different network without user intervention. Likewise, Wilson’s system for reconfiguring and registering a new IP address for a

computer to access a different network without user intervention is not pertinent to the problems solved by Vaidyanathan's digital file marketplace.

"If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01.

The modification proposed by combining Dillon with the additional cited prior art would render Dillon unsatisfactory for its intended purpose. The combination of these references would give a customer no reason to be guided to Bayles' web site, Toda's single monitored web site or Vaidyanathan's digital file marketplace, because Dillon teaches that the content from these web sites or the digital file marketplace would already be received and/or cached on the customer's local hard disk. The customer would not need to be guided, since the content would be available to the customer locally.

Likewise, the modification proposed by combining Wilson with the additional cited prior art would render Wilson unsatisfactory for its intended purpose. The combination of these references would make it impossible for a customer to customize an administrative web site as claimed, because the site taught by Wilson "is a server-only solution and ... is designed to operate without modifications." (Wilson, column 5, lines 11-19).

Because the prior art references are non-analogous art, Applicant respectfully requests allowance of claims 1-20.

4. The prior art references are combined using impermissible hindsight.

"Impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." MPEP § 2142. "Knowledge of applicant's disclosure must be put aside in reaching this determination." MPEP § 2145.

The OA used impermissible hindsight to combine the prior art references. The OA gives three reasons for combining Bayles, Vaidyanathan, Toda and Dillon. Bayles and Vaidyanathan were combined "to allow maintaining the third party website," (OA, page 4, lines 3-6).¹ Toda is added to the combination "to allow guiding the user to the desired web page." (OA, page 4, lines

¹ The OA concedes that maintaining a third party website is not taught in Bayles or Vaidyanathan. (OA, page 7, line 3).

11-15). Dillon is added to the combination “to provide assistance to the user who is not educated enough to make the registration alone.” (OA, page 5, lines 1-5).²

Bayles, Wilson and Vaidyanathan were likewise combined “to allow monitoring who is connected and registered to the network.” (OA, page 7, lines 7-12).

Sections II (C) (1-3) above establish that the prior art should not have been combined. Without sound reasons for combining this art, the legal conclusion can’t be based on facts gleaned from the prior art. Impermissible hindsight was therefore used in combining the prior art references, because the OA used knowledge of the applicant’s disclosure in reaching this determination.

Because the prior art references are combined using impermissible hindsight, Applicant respectfully requests allowance of claims 1-20.

² Dillon is not cited in the combination of references. However, it is presumed that the second reference to “Vaid” was intended to refer to Dillon. Also, it is unclear how this motivation to combine relates to the claimed invention, as “providing assistance to uneducated users” is not a limitation in claims 1-5 or 11-15.

CONCLUSION

All claims currently present in this application are believed allowable over all of the art of record and prompt further examination of the application and its allowance are respectfully requested.

Any questions or suggestions regarding the application or the amended claims submitted herewith should be directed to the undersigned attorney for the Applicant at the telephone number listed below or by email to the email address listed below.

No fees are believed necessary. However, authorization is given to charge any additional fees associated with this communication to Go Daddy's deposit account No. 503134.

Respectfully submitted,

The Go Daddy Group, Inc.

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